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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,745	07/03/2001	Ronald W. Davis	STAN-153	3662

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EXAMINER

STRZELECKA, TERESA E

ART UNIT	PAPER NUMBER
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1637

9

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/898,745	DAVIS ET AL.	
	Examiner	Art Unit	
	Teresa E Strzelecka	1637	

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,9-13,15-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 9-11, 15, 16 is/are allowed.
- 6) ☒ Claim(s) 4,7,12,13,17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. This Office action is in response to an amendment filed on January 27, 2003. Claims 1-20 were previously pending, all were rejected.

2. Applicants cancelled claims 2, 3, 5, 6, 8, 14 and 18 and amended claims 1, 7, 9-11, 13, 15-17 and 20. Claims 1, 4, 7, 9-13, 15-17, 19 and 20 are pending and will be examined.

3. In view of Applicants' amendments and claim cancellations the following rejections are withdrawn: rejection of claims 1-20 under 35 U.S.C. 112, first paragraph, enablement; rejection of claims 3, 5-7 and 11-16 under 35 U.S.C. 112, second paragraph; rejection of claims 1, 2, 4, 5 and 17 under 35 U.S.C. 102(a) and rejection of claims 18-20 under 35 U.S.C. 103.

4. New grounds of rejection have been introduced by claim amendments.

Claim Rejections - 35 USC § 112

5. Claims 4, 7, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 4 is indefinite over the recitation of "the host cell". It is not clear to which host cell this term refers. Claim 1, from which claim 4 depends, contains the following limitations: "a yeast host cell" (line 3) and "a control host cell" (line 7).

B) Claim 7 is indefinite over the recitation of "each host cell". It is not clear to which host cell this term refers. Claim 7 is drawn to at least two or more host cells with heterozygous deletions. Claim 1, from which claim 7 depends, contains the following limitations: "a yeast host cell" (line 3) and "a control host cell" (line 7), therefore it is not clear whether "each host cell" refers just to host cells with heterozygous deletions or to all host cells, including the control host cell.

C) Claim 12 is indefinite over the recitation of “the host cell”. It is not clear to which host cell this term refers. Claim 11, from which claim 12 depends, contains the following limitations: “a yeast host cell” (line 3) and “a wildtype host cell” (line 7).

D) Claim 13 is indefinite over the recitation of “each host cell”. It is not clear to which host cell this term refers. Claim 13 is drawn to at least two or more strains with heterozygous deletions. It is not clear whether two or more strains with heterozygous deletions correspond to an equivalent number of different host cells. Claim 11, from which claim 13 depends, contains the following limitations: “a yeast host cell” (line 3) and “a control host cell” (line 7), therefore it is not clear whether “each host cell” refers just to host cells with heterozygous deletions or to all host cells, including the wildtype host cell.

E) Claim 13 is indefinite over the recitation of “... at least two or more heterozygous deletion strains are contacted...”. Claim 11, from which claim 13 depends, does not contain a limitation referring to heterozygous deletion strains.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockhart et al. (U. S. Patent No. 6,333,155 B1).

Regarding claim 17, Lockhart et al. teach contacting yeast cells with two drugs, compound 52 and flavipiridiol, and monitoring expression of over 6200 genes in response to these drugs by

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contacting cRNA obtained from cells exposed to the drugs with an oligonucleotide probe array (col. 3, lines 18-34). One set of genes affected were genes involved in phosphate metabolism. For example, expression of the heat shock protein HSP12 increased (col. 3, lines 49-65). Another set of genes affected were cellular metabolism genes, of which the heat shock genes HSP26, HSP30, HSP82, HSP104 and SSE2 were upregulated (col. 4, lines 6-29).

Regarding claim 19, Lockhart et al. teach nucleic acids obtained from biological samples, such as clinical samples, which comprise sputum, blood, blood cells, biopsy samples, urine, etc. (col. 12, lines 9-29).

Regarding claim 20, Lockhart et al. teach control samples (col. 22, lines 1-10), cell cultures (col. 12, lines 24-29) and kits comprising sets of oligonucleotides (= reagent for detection of gene expression) for detection of genes which are up-regulated or down-regulated by a drug (col. 6, lines 14-46).

8. No references were found teaching or suggesting claims 1, 4, 7, 9-13, 15 and 16. Claims 4, 7, 12 and 13 are rejected for reasons given above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (703) 306-5877. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

TS
April 15, 2003

TS

Kenneth R. Horlick
KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

4/15/03